

## EASTERN DIVISION

YM

## COMPLAINT FOR DAMAGES AND INJUNCTIVE RELIEF

Plaintiff Chaf Enterprises, Inc. (“Chaf”), by and through its undersigned counsel, brings its Complaint against Defendant Chayanne.com, Ltd. (the “Registrant”) seeking relief pursuant to 15 U.S.C. § 1125(d)(1) for Registrant’s bad-faith use and registration of the domain name <chayanne.com> (the “Infringing Domain Name”). In the alternative, Plaintiff also seeks redress through an *in rem* civil action pursuant to 15 U.S.C. § 1125(d)(2) against the domain name <chayanne.com>.

## SUMMARY OF ACTION

1. This is an action brought pursuant to the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)(1). Plaintiff is the owner of the valuable CHAYANNE trademark (the “CHAYANNE Mark”), which is the famous and well-known performing name of the artist Elmer Figueroa Arce. Mr. Arce has been using and performing under the name Chayanne since 1984, and has achieved global recognition for his vocal talent, dance choreography, and on-screen performances. Some of Chayanne’s more notable accolades include more than 100 platinum and gold records, being honored with several Grammy nominations, receiving an MTV

Award for Best International Video, and starring in several television programs as well as the 1998 feature-length movie, *Dance with Me*. In addition, Chayanne has had over 24 top ten hits on the Billboard charts, including nine number one singles on the Billboard Hot Latin Chart. His last four albums have reached top ten in the album charts and have remained there for over 160 weeks. Chayanne interacts with his fans through the Internet website <chayanne.net>.

2. Notwithstanding Plaintiff's rights to the CHAYANNE Mark, and despite having no legitimate reason to do so, Defendant Registrant registered and used the Infringing Domain Name in connection with the promotion of goods and services related to music and male celebrities. Registrant's use of the CHAYANNE Mark in a confusingly similar domain name for products and services constitutes a violation of the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d).

3. In the alternative, Plaintiff brings this as an *in rem* action under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)(2), for injunctive and other relief relating to the bad-faith registration and use of the Infringing Domain Name, namely, <chayanne.com>, individually and collectively, which is also named as a Defendant in this Complaint.

### **THE PARTIES**

4. Chaf Enterprises, Inc. is a Florida corporation having its principal place of business at 1717 North Bayshore Drive, Suite 2146, Miami, Florida 33132. Chaf is the registrant of record of the famous CHAYANNE Mark.

5. Upon information and belief, Defendant Registrant is a Canadian company with a mailing address of P.O. Box 939, Quebec, Canada G1R 4T9 and is the registrant of record of the

Infringing Domain Name. A true and correct copy of the WHOIS record for the Infringing Domain Name is attached hereto as **Exhibit 1**.

6. Defendant <chayanne.com> is an Internet domain name that Defendant Registrant registered through Signature Domains, Inc., and by virtue of its <.com> top level domain extension, resides in the VeriSign, Inc. (“VeriSign”) <.com> registry.

### **JURISDICTION AND VENUE**

7. Registrant has directed its business activities toward Illinois as the websites to which the Infringing Domain Name resolves feature content that may be purchased, and upon information and belief have been purchased, by consumers located in Illinois.

8. In addition, this Court has *in rem* jurisdiction over the Infringing Domain Name under 15 U.S.C. § 1125(d)(2)(C), because the Infringing Domain Name registry, VeriSign, is located in this judicial district.

9. This Court has subject matter jurisdiction under the Lanham Act pursuant to 15 U.S.C. § 1121 and 28 U.S.C. §§ 1331, 1338(a) and 1338(b).

10. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), (c) and (d).

11. Venue is also proper in this district pursuant to 28 U.S.C. § 1391 and 15 U.S.C. § 1125(d)(2)(C) because the *res*, *i.e.*, the Infringing Domain Name, is located in this judicial district.

### **ALLEGATIONS COMMON TO ALL COUNTS**

#### **Plaintiff’s Famous Mark**

12. Chayanne is recognized by fans of all ages as one of the most talented performance artists of this century. Mr. Arce began his professional singing career with the musical group “Los Chicos” in 1978, and began using Chayanne as his stage-name in 1984 when

he began his career as a solo artist. Ever since, Mr. Arce has been performing and publishing music under the name “Chayanne,” with his most recent album “Mi Tiempo” being released in April 2007. Chayanne is also known for his roles in several television shows and starring with Vanessa Williams and Kris Kristofferson in the feature-length movie, *Dance with Me*.

13. Among other applications and registrations, the mark CHAYANNE, U.S. Reg. No. 3,019,298, was registered on November 29, 2005 for “musical sound recordings comprising a series and audiovisual recordings, namely, compact discs, tape cassettes, phonographic records, CD-ROMS, DVDs, videotapes and laser discs.” A true and correct copy of the Trademark Registration Record as maintained by the United States Patent and Trademark Office for the CHAYANNE mark, U.S. Registration Number 3,019,298, is attached as **Exhibit 2**.

14. Likewise, the mark CHAYANNE, U.S. Reg. No. 3,175,809, was registered on November 28, 2006 for “entertainment services in the nature of live musical performances by an individual and presentation of prerecorded vocal and musical performances.” A true and correct copy of the Trademark Registration Record as maintained by the United States Patent and Trademark Office for the CHAYANNE mark, U.S. Registration Number 3,175,809, is attached as **Exhibit 3**.

15. The CHAYANNE Mark has been in continual use by Plaintiff, its affiliates, and/or licensees since 1984.

16. The CHAYANNE Mark represents to the worldwide consuming public the goods and services offered by Plaintiff Chaf and its affiliates and/or licensees.

17. Plaintiff Chaf has made extensive use of the CHAYANNE Mark by promoting and providing its entertainment services throughout the United States.

18. Due to the extensive use and registration of the CHAYANNE Mark, the CHAYANNE Mark has become famous.

**Defendant Registrant's Bad-Faith Registration of the Infringing Domain Name**

19. Subsequent to Plaintiff's use of the CHAYANNE Mark in commerce, and without Plaintiff's consent or the sanction of any court of law's ruling that Registrant owns any rights whatsoever to exploit the CHAYANNE Mark for commercial use, and without the benefit of any common law trademark or service mark rights or ownership of registrations for CHAYANNE in any form, Registrant registered the Infringing Domain Name with Signature Domains, Inc.

20. The Infringing Domain Name is a top level domain name ending in <.com>, and as such, it is located in the VeriSign <.com> registry.

21. The Infringing Domain Name resolves to a pay-per-click website that features various links to websites that advertise or sell competing products and services.

22. For example, one of the links prominently presented when an Internet user navigated to the Infringing Domain Name advertised music downloads, while another advertised male celebrities. True and correct printouts obtained by domaintools.com of the websites associated with the Infringing Domain Name over the years are attached as **Exhibit 4**.

23. Registrant is either the actual or beneficial owner of the Infringing Domain Name.

24. Registrant used the Infringing Domain Name in conjunction with online advertising for products and businesses that directly compete with Plaintiff.

25. Registrant is not affiliated with Plaintiff and is not authorized to use Plaintiff's trademarks or to profit from the goodwill Plaintiff has generated in the CHAYANNE Mark.

26. Registrant has no legitimate reason to use Plaintiff's CHAYANNE Mark in connection with its online commercial activities.

27. Without any legal basis, statutory or otherwise, for asserting rights to advertise or otherwise sell products or services in commerce in conjunction with Plaintiff's famous CHAYANNE Mark, Defendant Registrant registered the Infringing Domain Name with a bad-faith intent to profit from the goodwill and value associated with the CHAYANNE Mark.

28. Upon information and belief, with full knowledge of Plaintiff's exclusive rights in the CHAYANNE Mark, Registrant is attempting to confuse Plaintiff's customers and to divert them to the webpages represented by the Infringing Domain Name.

29. Registrant and the Infringing Domain Name have deliberately harmed, and will continue to harm, the goodwill enjoyed by the CHAYANNE Mark in the United States and abroad among virtually all consumers by creating a false association between the genuine products and services provided by Plaintiff and those associated with Defendants.

30. Registrant registered the Infringing Domain Name despite the fact that it lacks any legitimate intellectual property rights whatsoever in the CHAYANNE Mark in the United States.

31. The Infringing Domain Name is virtually identical to Plaintiff's protectable Chayanne mark, and incorporates the CHAYANNE Mark in its entirety. Thus, the Infringing Domain Name is confusingly similar to, and dilutive of, the famous CHAYANNE Mark – and violates Plaintiff's exclusive trademark and service mark rights in the CHAYANNE Mark in the United States and abroad.

32. Upon information and belief, Registrant registered the Infringing Domain Name despite its actual knowledge of the CHAYANNE Mark, its acute awareness of the popularity and recognition associated with the CHAYANNE Mark as the moniker of the international performer

Chayanne, its knowledge of the famousness and distinctiveness of the CHAYANNE Mark, and its knowledge that it has no intellectual property rights in the CHAYANNE Mark.

33. Registrant's use of the Infringing Domain Name, which contains Plaintiffs' CHAYANNE Mark in its entirety, results in the likelihood that consumers will mistakenly believe that Registrant is associated, affiliated, or otherwise conducting business with Plaintiff.

34. Registrant's conduct was and is intentional and willful and designed to unlawfully misappropriate Plaintiff's goodwill and reputation and to unfairly divert to Registrant Internet traffic intended for Plaintiff.

**COUNT I**  
**Cybersquatting Under the Anticybersquatting Consumer Protection Act**  
**Against Registrant**  
**(15 U.S.C. § 1125(d)(1))**

35. Plaintiff realleges and incorporates by reference the foregoing paragraphs as if fully set forth herein.

36. The Infringing Domain Name incorporates the CHAYANNE Mark in its entirety and is nearly identical and confusingly similar to, and dilutive of, Plaintiff's CHAYANNE Mark.

37. The CHAYANNE Mark was distinctive and/or famous at the time Registrant registered the Infringing Domain Name.

38. Registrant registered, trafficked in, and/or used the Infringing Domain Name with a bad-faith intent to profit from Plaintiff's CHAYANNE Mark.

39. Registrant's registration, trafficking in, and/or use of the Infringing Domain Name has caused, and is likely to continue to cause, irreparable harm to Plaintiff's goodwill and reputation.

40. Registrant's actions were willful, and Plaintiff has no adequate remedy at law.

41. Registrant's activities as alleged herein constitute a violation of the federal Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d).

42. As a result of Registrant's willful and intentional actions, Plaintiff has incurred attorneys' fees and costs.

43. As a result of Registrant's willful and intentional actions, Plaintiff has been damaged in an amount to be proven at trial.

**COUNT II**

**[In the Alternative]**

***In Rem* Action Under the Anticybersquatting Consumer Protection Act  
Against Infringing Domain Name <chayanne.com>  
(15 U.S.C. § 1125(d)(2))**

44. Plaintiff realleges and incorporates by reference paragraphs 1-34 as if fully set forth herein.

45. As set forth above, and under Section 1125(d)(2)(A)(i), the Infringing Domain Name violates Plaintiff's rights in connection with the CHAYANNE Mark because the Infringing Domain Name is confusingly similar to the CHAYANNE Mark and is dilutive of the CHAYANNE Mark.

46. Upon information and belief, Registrant owns no trademark rights in, and no trademark registrations for, the CHAYANNE Mark in the United States or elsewhere.

47. Registrant's continued registration and/or use of the Infringing Domain Name with a bad-faith intent to profit constitutes a violation of 15 U.S.C. § 1125(d)(1) and 1125(d)(2), which protects the owner of U.S. trademarks and prohibits the registration of Internet domain names that are confusingly similar to any trademark, or dilutive of any famous trademark.



**RELIEF REQUESTED**

WHEREFORE, Plaintiff Chaf Enterprises, Inc. respectfully requests that this Court enter an order for Plaintiff and against Defendants as follows:

(a) Defendant Registrant and its respective agents, representatives, servants, employees, attorneys, officers, directors, shareholders, licensees, affiliates, joint venturers, parents, subsidiaries, related corporations and all others in privity or acting in concert with it be preliminarily and permanently enjoined from:

- (i) Using, linking to, transferring, selling, exercising control over, or otherwise owning the Infringing Domain Name or any other domain name or trademark or service mark that incorporates, in whole or in part, Plaintiff's CHAYANNE Mark;
- (ii) Using false representations or descriptions in commerce or using false designations of origin that are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendant Registrant with Plaintiff, or as to the origin, sponsorship, or approval of Defendant Registrant's services by Plaintiff;
- (iii) Otherwise infringing Plaintiff's CHAYANNE Mark; and
- (iv) Unfairly competing with Plaintiff or otherwise injuring its business reputation in any manner;

(b) Defendant Registrant be ordered to transfer the Infringing Domain Name <chayanne.com> to Plaintiff;

(c) Defendant Registrant be required to pay to Plaintiff statutory damages in an amount not less than \$100,000 pursuant to the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d);

(d) Defendant Registrant be ordered to pay Plaintiff its attorneys' fees and costs; and

(e) Plaintiff be awarded such other and further relief as this Court may deem just.

Respectfully submitted,

CHAF ENTERPRISES, INC.

Dated: July 11, 2008

/s/ Paul D. McGrady, Jr.

One of Its Attorneys

Paul D. McGrady, Jr. (ARDC # 6239525)  
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*Attorneys for Plaintiff Chaf Enterprises, Inc.*

## **EXHIBIT 1**

08CV3958

JUDGE LINDBERG

MAGISTRATE JUDGE COLE

YM

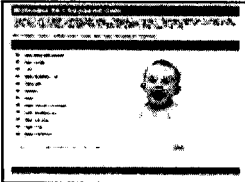
WHOIS Search Results

Available chayanne extensions:

<input type="checkbox"/> .biz	<input type="checkbox"/> .tv	<input type="checkbox"/> .co.uk	<input type="checkbox"/> .bz
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Order Selected Domain(s)

Your WHOIS Search Results



chayanne.com

Make an instant, anonymous offer to the current domain registrant. [Learn More](#)

Make an offer to buy this domain

The information in this whois database is provided for the sole purpose of assisting you in obtaining information about domain name registration records. This information is available "as is," and we do not guarantee its accuracy. By submitting a whois query, you agree that you will use this data only for lawful purposes and that, under no circumstances will you use this data to: (1) enable high volume, automated, electronic processes that stress or load this whois database system providing you this information; or (2) allow, enable, or otherwise support the transmission of mass, unsolicited, commercial advertising or solicitations via facsimile, electronic mail, or by telephone to entities other than your own existing customers. The compilation, repackaging, dissemination or other use of this data is expressly prohibited without prior written consent from this company. We reserve the right to modify these terms at any time. By submitting an inquiry, you agree to these terms of usage and limitations of warranty. Please limit your queries to 10 per minute and one connection.

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Premium Name

- ☐ annelies.com \$2,688
- ☐ buyinghay.com \$249
- ☐ haymakers.net \$2,488
- ☐ hayanalysis.com \$249
- ☐ haygroup.net \$1,188
- ☐ hayraking.com \$249
- ☐ hayford.net \$488

Misspellings

- ☐ chayannne.com
- ☐ choyanne.com
- ☐ chayonne.com
- ☐ chayann3.com
- ☐ chayannee.com

Domain Services Provided By:  
Signature Domains, support@signaturedomains.com  
www.signaturedomains.com

Registrant:  
Chayanne.com, Limited  
P.O. Box 939  
Quebec, Canada G1R 4T9  
CA

Registrar: SIGNATURE  
Domain Name: CHAYANNE.COM  
Created on: 15-APR-02  
Expires on: 15-APR-09  
Last Updated on: 01-APR-08

Administrative, Technical Contact:  
chayanneadmin@gmail.com  
Chayanne.com, Limited  
P.O. Box 939  
Quebec, Canada G1R 4T9  
CA  
418-808-7800

Domain servers in listed order:  
NS3.SIGNATUREDOMAINS.COM  
NS4.SIGNATUREDOMAINS.COM

End of Whois Information  
The previous information has been obtained either directly from the registrant or a registrar of the domain name other than Network Solutions. Network Solutions, therefore, does not guarantee its accuracy or completeness.

[Show underlying registry data for this record](#)

**Current Registrar:** SIGNATURE DOMAINS, LLC  
**IP Address:** 206.207.85.33 (ARIN & RIPE IP search)  
**IP Location:** US(UNITED STATES)-IDAHO-BOISE  
**Record Type:** Domain Name  
**Server Type:** Apache 2  
**Lock Status:** clientDeleteProhibited  
**Web Site Status:** Active  
**DMOZ** no listings  
**Y! Directory:** see listings  
**Web Site Title:** Chayanne.com  
**Secure:** No  
**E-commerce:** Yes  
**Traffic Ranking:** 3  
**Data as of:** 07-Apr-2008

- ☐ chayanen.com
- ☐ chaynane.com
- ☐ chayanne.com

**Similar Names**

- ☐ chayannehome.c
- ☐ chayanneworld.c
- ☐ chayanneplanet.c
- ☐ chayannenation.c
- ☐ chayannefamily.c
- ☐ chayanneblog.cor
- ☐ chayanneade.com
- ☐ jacobschayanne.c

**Add Don**

**SEARCH AGAIN**

**Enter a search term:**

e.g. networksolutions.c

- Search by:**
- ☒ Domain Name
  - ☐ NIC Handle
  - ☐ IP Address

## **EXHIBIT 2**



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# CHAYANNE

<b>Word Mark</b>	CHAYANNE
<b>Goods and Services</b>	IC 009. US 021 023 026 036 038. G & S: Musical sound recordings comprising a series and audiovisual recordings, namely, compact discs, tape cassettes, phonographic records, CD-ROMS, DVDs, videotapes and laser discs. FIRST USE: 19840000. FIRST USE IN COMMERCE: 19840000
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	76597600
<b>Filing Date</b>	June 16, 2004
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	September 6, 2005
<b>Registration Number</b>	3019298
<b>Registration Date</b>	November 29, 2005
<b>Owner</b>	(REGISTRANT) Chaf Enterprises, Inc. CORPORATION FLORIDA 1717 North Bayshore Drive Suite 2146 Miami FLORIDA 33132
<b>Attorney of Record</b>	Manuel R. Valcarcel
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Other Data</b>	The name "CHAYANNE" identifies a living individual whose consent is of record.
<b>Live/Dead Indicator</b>	LIVE

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## **EXHIBIT 3**





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**CHAYANNE**

<b>Word Mark</b>	CHAYANNE
<b>Goods and Services</b>	IC 041. US 100 101 107. G & S: Entertainment services in the nature of live musical performances by an individual and presentation of prerecorded vocal and musical performances. FIRST USE: 19840000. FIRST USE IN COMMERCE: 19840000
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	76597604
<b>Filing Date</b>	June 16, 2004
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	September 12, 2006
<b>Registration Number</b>	3175809
<b>Registration Date</b>	November 28, 2006
<b>Owner</b>	(REGISTRANT) Chaf Enterprises, Inc. CORPORATION FLORIDA 1717 North Bayshore Drive Suite 2146 Miami FLORIDA 33132
<b>Attorney of Record</b>	Manuel R. Valcarcel
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Other Data</b>	"CHAYANNE" identifies a living individual whose consent is of record.
<b>Live/Dead Indicator</b>	LIVE

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## **EXHIBIT 4**

Chayanne.com

April 23, 2007

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Search

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MP3s

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1. The first group of people who are interested in the study of the history of the United States are the people who are interested in the history of the United States. They are interested in the history of the United States because they want to know more about the United States. They want to know more about the United States because they want to know more about the United States.

[illegible]

chayanne.com

August 28, 2005

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lavo duggs	Airline Tickets	Online Banking	Free Casino Games
supermodel photo gallery	Hotels	Online Payment	Poker
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supermodel gallery	all	all	all
american beauty	Car Insurance	Music	Real Estate Training
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|-------------------|---------------------------------|---------------------------------|------------------------------------|--------------------------------|
| ➤ Blank media     | <a href="#">Blank Media</a>     | <a href="#">Karaoke music</a>   | <a href="#">Napster</a>            | <a href="#">Music download</a> |
| ➤ Karaoke music   | <a href="#">Blank Media</a>     | <a href="#">Karaoke Music</a>   | <a href="#">Unauthorized Query</a> | <a href="#">MP3</a>            |
| ➤ Napster         | <a href="#">Blank Media</a>     | <a href="#">Karaoke</a>         | <a href="#">Query</a>              | <a href="#">DVD-R</a>          |
| ➤ Music download  | <a href="#">Blank Media</a>     | <a href="#">Karaoke Machine</a> | <a href="#">Unauthorized Query</a> | <a href="#">DVD-Rewriter</a>   |
| ➤ Satellite radio | <a href="#">Blank Media</a>     | <a href="#">Music.MP3</a>       | <a href="#">Unauthorized Query</a> | <a href="#">CD-Rewriter</a>    |
| ➤ Buy music       | <a href="#">Blank Media</a>     | <a href="#">Karaoke Songs</a>   | <a href="#">Unauthorized Query</a> | <a href="#">Free Music</a>     |
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| ➤ MP3 player      | <a href="#">Blank Media</a>     |                                 | <a href="#">Unauthorized Query</a> |                                |
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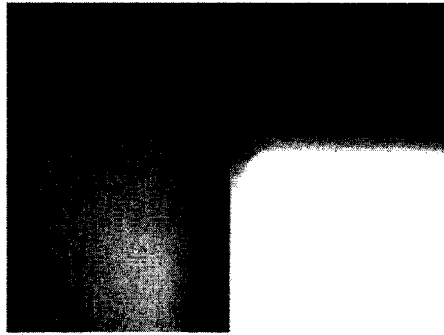
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